

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Roberto BURIONI

U.S. Serial No. : 10/502,307

Confirmation No. : 9195

Filed : July 22, 2004

Examiner : Zachariah Lucas

Art Unit : 1645

For : HUMAN MONOCLONAL ANTIBODY FAB FRAGMENTS
DIRECTED AGAINST HCV E2 GLYCOPROTEIN AND
ENDOWED WITH IN VITRO NEUTRALIZING ACTIVITY

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February 14, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

**RESPONSE TO AUGUST 23, 2006 RESTRICTION REQUIREMENT AND
PETITION FOR EXTENSION OF TIME**

This Response and Petition are submitted in response to the Office Action mailed August 23, 2006. A response to the August 23, 2006 Office Action was originally due on September 23, 2006. Applicant hereby petitions for a five-month extension of time, and pays the corresponding fee of ONE THOUSAND AND EIGHTY DOLLARS (\$1080.00) for a small entity. Accordingly, a response is now due on February 23, 2007, and this Response is being timely filed.

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Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that under 35 U.S.C. § 121 and 372, restriction to one of the following groups of inventions is required:

- I. Claims 1-3, 27, 28, drawn to neutralizing anti-HCV antibodies that bind the HCB E2 protein.
- II. Claims 12-14, drawn to methods for validating anti-HCV vaccines using the antibodies of Group I.
- III. Claims 15-23, drawn to nucleic acids that encode the antibodies of Group I.
- IV. Claims 24-26, drawn to methods of using the nucleic acids of Group III.
- V. Claim 29, drawn to method for the detection of anti-HCV antibodies.

In response, Applicant respectfully traverses the above restriction.

Under MPEP, there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the Examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the

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merits, even though it includes independent claims or distinct inventions.

Applicant submits that claims 1-3, 12-23, 27 and 28, Groups I-III, do not require restriction as they are connected by a single relationship, namely neutralizing anti-HCV antibodies. The method of using anti-HCV antibodies to validate anti-HCV vaccines (Group II) clearly depends on a special technical feature of anti-HCV antibodies (Group I).

In addition, Applicant maintains that the Examiner would not be seriously burdened by searching and examining all of the pending claims in a single application. A search for anti-HCV antibodies (Group I) will reveal method of using anti-HCV antibodies to validate anti-HCV vaccines (Group II) (MPEP § 802.01). Similarly, a search for anti-HCV antibodies (Group I) will reveal nucleic acids that encode the anti-HCV antibodies (Group III).

Given the single, searchable relationship, the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application. (See MPEP § 803.02, § 806.04(a)-§ 806.04(i), § 808.01(a), and § 808.02). Accordingly, Applicant respectfully requests the restriction of claims 1-3, 12-23, 27 and 28 be withdrawn.

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicant hereby elects Group I, claims 1-3, 27, 28 for examination. Applicant further elects an embodiment wherein the antibody is that described in claim 2.

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If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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